

Appl. No. 09/851,054
Amdt. Dated August 23, 2004
Reply to Office Action of April 21, 2004

REMARKS

Reconsideration of the application is requested.

Applicant acknowledges the Examiner's confirmation of receipt of applicant's certified copy of the priority document for the German Patent Application 200 08 548, filed May 8, 2000 supporting the claim for priority under 35 U.S.C. § 119.

Claims 1-12 are in the application. Claims 1, 11, and 12 were rejected under 35 USC § 102(b) and claims 2-10 were rejected under 35 USC § 103(a) in the above-identified Office Action.

In "Claim Rejections - 35 USC § 102" on page 2 of the above-identified Office Action, claims 1, 11, and 12 have been rejected as being fully anticipated by U.S. Patent No. 5,376,920 to Baily (hereinafter **BAILY**) under 35 U.S.C. § 102(b). Applicant respectfully requests the addition of **BAILY** to the Notice of References Cited (PTO-892).

In "Claim Rejections - 35 USC § 103" on page 3 of the above-identified Office Action, claims 2-7 have been rejected as being obvious over **BAILY**.

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In "Claim Rejections - 35 USC § 103" on page 4 of the above-identified Office Action, claims 8-10 have been rejected as being obvious over **BAILY** in view of European Patent Application 0 327 881 A1 to **Hartmann, et al.** (hereinafter **HARTMANN**) under 35 U.S.C. § 103(a). Please note that **HARTMANN** was previously identified incorrectly in the above-identified Office Action and item N of the Notice of References Cited as "Thompson," which is actually the assignee Deutsche Thomson-Brandt GmbH.

The rejections have been noted, however, as will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a switch off delay

a power switch having given switch positions and including a first switch and a second switch, said first switch being connected in series with said second switch;

said first switch and said second switch selectively opening and closing only jointly;

a sensor having a first input, a second input, and an output;

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said second input of said sensor to be connected to a first conductor selected from the group consisting of a first live conductor, a second live conductor, and a neutral conductor;

said second switch having a first contact and a second contact, said first contact to be connected to a second conductor selected from the group consisting of the first live conductor, the second live conductor, and the neutral conductor;

said second contact of said second switch being connected to said first input of said sensor for passing a measurement current to said first input of said sensor when a voltage is applied and said power switch is switched on; and

a microprocessor operatively connected to said sensor, said output of said sensor transmitting an output signal corresponding to one of the given switch positions of said power switch to said microprocessor.

Independent claims 11 and 12 contain similar language.

Specifically, claim 11 calls for, *inter alia*, a

microprocessor-controlled appliance including:

a power switch having given switch positions and including a first switch and a second switch, said first switch being connected in series to said second switch;

said first switch and said second switch selectively opening and closing only jointly;

a sensor operatively connected to said microprocessor and having a first input, a second input, and an output;

said second input of said sensor to be connected to a first conductor selected from the group consisting of a first live conductor, a second live conductor, and a neutral conductor;

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said second switch having a first contact and a second contact, said first contact to be connected to a second conductor selected from the group consisting of the first live conductor, the second live conductor, and the neutral conductor;

said second contact of said second switch being connected to said first input of said sensor for passing a measurement current to said first input of said sensor when a voltage is applied and said power switch is switched on; and

a microprocessor operatively connected to said sensor, said output of said sensor transmitting an output signal corresponding to one of the switch positions of said power switch to said microprocessor.

Claim 12 calls for, *inter alia*, a microprocessor-controlled franking machine including:

a power switch having given switch positions and including a first switch and a second switch, said first switch being connected in series to said second switch;

said first switch and said second switch selectively opening and closing only jointly;

a sensor operatively connected to said microprocessor and having a first input, a second input, and an output;

said second input of said sensor to be connected to a first conductor selected from the group consisting of a first live conductor, a second live conductor, and a neutral conductor;

said second switch having a first contact and a second contact, said first contact to be connected to a second conductor selected from the group consisting of the first live conductor, the second live conductor, and the neutral conductor;

said second contact of said second switch being connected to said first input of said sensor for passing a measurement current to said first input

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of said sensor when a voltage is applied and said power switch is switched on;

a microprocessor operatively connected to said sensor, said output of said sensor transmitting an output signal corresponding to one of the switch positions of said power switch to said microprocessor; and

a franking machine meter operatively connected to said microprocessor.

In contrast to the claimed invention, the **BAILY** reference discloses a power fail detection circuit including a "double pole, double throw (DPDT) switch 1" that is connected between a power supply and an electrically powered apparatus. More specifically, the DPDT switch of **BAILY** includes a first switch (3,7,11) that is connected in parallel with a second switch (5, 9, 13).

As previously indicated, claims 1, 11, and 12 of the instant application each clearly recite "a power switch ... including a first switch and a second switch, said first switch being connected in series with said second switch" NOT in parallel as illustrated and described in **BAILY**.

In further contrast, **BAILY** also teaches connecting a contact (power-OFF terminals 11 and 13) from each of the first and second switches to a first and a second input of the sensor (transient protection circuit 15) when the power switch is switched "off." When the power switch 1 of **BAILY** is switched

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"on" the inputs of the sensor are open. (col. 2, line 50 -
col. 3, line 4).

As previously indicated, claims 1, 11, and 12 of the instant application all indicate the "second contact of said second switch being connected to said first input of said sensor ... when ... said power switch is switched on" NOT when the power is switched OFF as required in BAILY.

MPEP § 2131 states that before BAILY anticipates a claim, BAILY must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

More specifically, MPEP § 2131 also indicates that "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the instant case, BAILY teaches the use of parallel switches, NOT "switches connected in series" as recited in claims 1, 11, and 12 of the instant application, and

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therefore does not establish a *prima facie* case of anticipation.

Moreover, **BAILY** only connects the contacts of the switch to the sensor when the power switch is **switched off**, **NOT** "**switched on**" as recited in claims 1, 11, and 12 of the instant application, further supporting the applicant's position that the above-identified Office Action does not establish a *prima facie* case of anticipation.

Clearly, **BAILY** does not anticipate the instant application.

With regards to claims 2-7, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by **BAILY**. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). **BAILY** actually teaches away from the invention in at least the two instances previously discussed. These differences are more than sufficient to determine that no case of *prima facie* obviousness may be found using **BAILY** alone. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). **BAILY**, without more, actually teaches away from the configuration in the instant application and therefore cannot establish *prima facie* obviousness.

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With regards to claims 8-10, the **HARTMANN** reference discloses a switched-mode power supply, with a shut off electronic switch (9) that switches off microseconds before the maximum permissible peak current is reached. As a result, the power supply in **HARTMANN** switches off a short time before a maximum value of current is reached. This feature is also inherently taught through the use of the switch-off delay, because the power supply must turn off before the maximum permissible peak current is reached. The response threshold for the protective circuit is detected to be sliding in dependence on the input voltage supplied to the switched-mode power supply. Thus, the shut-off initiation in **HARTMANN** is based on a timing switch programmed to turn off before a maximum permissible peak current is reached and not a register based configurations as indicated in claims 8 and 9; specifically, not "a sensor shift register" as recited claims 8 and 9, nor "an actuator shift register" as recited in claim 9.

Moreover, applicant respectfully traverses the position of the above-identified Office Action that **HARTMANN** teaches "a third switch connected in parallel" to a power switch as recited in claim 10. **HARTMANN** does not overcome the previously discussed deficiencies of **BAILY** and as such fails to establish a case of *prima facie* obviousness.

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Clearly, the combination of **HARTMANN** and **BAILY** does not show "switches connected in series" as recited in claims 1, 11, and 12 of the instant application. Nor, does the combination of **HARTMANN** and **BAILY** teach or suggest the "second contact of said second switch being connected to said first input of said sensor ... when ... said power switch is switched on" as recited in claims 1, 11, and 12 of the instant application.

Moreover, the combination of **HARTMANN** and **BAILY** does not show "a sensor shift register connected to said output of said sensor" as recited in claims 8 and 9 of the instant application. Nor does the combination of **HARTMANN** and **BAILY** show "an actuator shift register connected to said sensor shift register" as recited in claim 9 of the instant application. Finally, the combination of **HARTMANN** and **BAILY** does not show "a third switch connected in parallel to said power switch" as recited in claim 10 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 11, or 12. Claims 1, 11, and 12 is, therefore, believed to be patentable over

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the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1-12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

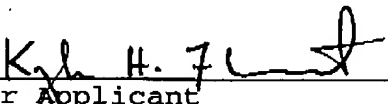
Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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